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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,150	04/27/2001	Pierre Chambon	065691/0219	7311

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EXAMINER

PARAS JR, PETER

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 08/14/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,150

Applicant(s)

CHAMBON ET AL.

Examiner

Peter Paras

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26-46 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24,26-46 and 49-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to a DNA molecule and a vector comprising the same vector, classified in classes 536 and 435, subclasses 23.1 and 320.1.
- II. Claims 26-31, and 35-38, drawn to an isolated transgenic host cell, and a method of obtaining a transgenic cell *in vitro* classified in classes 435 and 435, subclasses 325 and 455.
- III. Claims 32 and 49-50, drawn to a transgenic non-human organism, wherein the organism is a bacterium, classified in class 435, subclass 252.1.
- IV. Claims 32, 49-50 and 52, drawn to a transgenic non-human organism, wherein the organism is yeast, classified in class 435, subclass 254.2.
- V. Claims 32 and 49-51, drawn to a transgenic non-human organism, wherein the organism is a non-human animal, particularly a mouse, classified in classes 800, 800 and 800, subclasses 13, 14 and 18.
- VI. Claims 33-34 and 41, drawn to a method for stable inversion of a DNA sequence in a cell free system, classified in class 435, subclass 6.
- VII. Claims 33-34 and 42-46, drawn to a method for stable inversion of a DNA sequence in an isolated transgenic cell, classified in class 435, subclass 462.

VIII. Claims 39-40, drawn to a method to perform site-specific recombination mediated cassette exchange, classified in class 435, subclass 462.

Inventions I-V are unrelated each from the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions cannot be used together and have different modes of operation, functions, and effects. The nucleic acid molecule of Invention I can be used as a probe in a hybridization assay *in vitro*. The isolated transgenic cell of Invention II can be used to produce a protein. The transgenic organisms of Inventions III-V have different chemical structures and can be used in materially different methods each from the other. For example, the transgenic bacteria can be used as a vector for transforming animal cells, the transgenic yeast can be used to detect protein-protein interactions as in a two-hybrid assay, and the transgenic non-human animal can be used as a model of disease. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Inventions VI-VII are unrelated each from the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions can be used separately

Art Unit: 1632

and have different modes of operation. For example, the method of Invention VI can be practiced in a cell free system while the method of Invention VII can be practiced in an isolated transgenic cell such that the methods require different reagents and different technical considerations. The method of Invention VIII requires different method steps and materially different reagents from the methods of Inventions VI and VII. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Inventions I-V and VI-VIII are unrelated each from the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions can be used separately having different modes of operation, different functions, and different effects. The products of Inventions I-V can be used in methods that require materially different reagents and technical considerations from the methods of Inventions VI-VIII. The methods of Inventions VI-VIII can be practiced with different having different chemical structures that the products of Inventions I-V. For example, the nucleic acid molecule of Invention I can be used as a probe in a hybridization assay, the transgenic non-human animal of Invention V can be used for producing antibodies against an antigen, and the isolated transgenic cell of Invention II can be used to produce a protein. The method of Invention VI can be practiced in a cell system and the method of Invention VII can be used to genetically modify an isolated cell. Because these inventions are distinct for the

Art Unit: 1632

reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1632

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at 703-305-4051. Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703) 308-4242 and (703) 305-3014.

Inquiries of a general nature or relating to the status of the application should be directed to Patsy Zimmerman whose telephone number is (703) 308-0009.

Peter Paras, Jr.

Art Unit 1632

Peter Paras Jr
Art Unit 1632